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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,650	01/05/2001	Brett B. Stewart	5285-00106	7041

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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/755,650

Applicant(s)
Stewart

Examiner
James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 23, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13, 15-23, 26-36, 38-42, and 46-71 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13, 15-23, 26-36, 38-42, and 46-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 23, 2003 has been entered.

Response to Amendment

2. The Amendment filed on May 23, 2003 has been considered but is ineffective to overcome the Lawlor et al (6,202,054), Rudow et al (6,236,360), and Farmakis et al (5,714,948) references.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-9, 11-13, 15-23, 26-36, 38-42, and 46-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudow et al (6,236,360) in view of Lawlor et al (6,202,054) .

Claims 1, 13, 23, 39, and 42: Rudow discloses a system and method for providing information to users of mobile (portable) units, comprising:

- a. Transmitting a wireless signal from an access point to a mobile unit (col 18, lines 30-34);
- b. Receiving identification information from the mobile unit to an access point (col 12, lines 15-23); and
- d. Transmitting personalized information/messages to the mobile unit (col 4, lines 30-36; col 9, lines 35-39; and col 15, lines 42-50).

While Rudow discloses that the personalized messages could include advertisements, it is not explicitly disclosed that the advertisements are selected based upon past transactions of the user. However, Lawlor discloses a similar system and method for presented personalized information/messages to a user of a portable remote device and also discloses personalizing the information/messages based on the user's past transactions (col 13, lines 42-59; col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 39, lines 5-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to track the user's past transactions/actions in Rudow and to select the advertisements/messages based on such historical data. One would have been motivated to use the historical data in the selection process in order

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to present a targeted advertisement to the user, thus enhancing the revenue realized by the system through advertising and promotions as discussed by Rudow (col 5, lines 55-58).

While Rudow prefers that the remote terminal initiates the communication by transmitting its identification information to the access point, it is also disclosed that “The traditional scheme for solving this problem is for the base station to call individual users (e.g. “Cart 82, where are you?”), and the cart to which the inquiry is made sends a response” (col 18, lines 30-34).

Claims 5, 6, 18-20, 29, 30, 33, 40, 41; 46, 57-59, 70, and 71: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, 23, and 39 above, and Lawlor further discloses the information being advertisements pertaining to banking services, loans, or any other good or service as discussed in Claim 9 above. However, neither reference explicitly discloses that the access points are located in an airport or a hotel nor that the information is a travel itinerary. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the location of the access points and information provided would depend on the type of information providers in the system. In Rudow, the access points are located around the golf course and the information being provided pertains to the golfer’s game (i.e. distance from hole, etc.) or related advertisements/services (i.e. golf ball sale in clubhouse or personal messages to the golfer). Lawlor discloses that the remote device could be used anywhere that there is telephone service (e.g. cellular telephone aeri-als). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the access points in any desired area, such as an airport or hotel, and

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to provide information about goods or services of the particular information providers, such as travel agencies or airlines providing travel itineraries, hotels or car rental agencies providing information on reservations, etc. One would have been motivated to locate the access points in airports or hotels in order to target customers of such establishments, especially if the information provider was the hotel, an airline, car rental agency, or taxi service. The Examiner further notes that the location and ownership of the access points does not in any way affect the steps used to provide the personalized information or messages to the user of the remote device, and thus has no bearing on the patentability of such a method and corresponding system. As shown by the Applicant's claimed plurality of embodiments, the method and system could be used in any number of locations and circumstances to include airports, hotels, golf courses, amusement parks, shopping malls, or any other desired location.

Claims 2, 15, 26, 47, and 60: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, 23, 43, 46, and 59 above; and Lawlor further discloses that the past transactions include the requirements, preferences and/or habits of the user (col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 39, lines 5-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such data in the Rudow system when selecting the advertisements. One would have been motivated to include the requirements, preferences and/or habits of the user in order to better target the advertisement.

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Claims 3, 16, 27, 48, and 61: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, 23, 46, and 59 above; and Lawlor further discloses that the past transaction information includes information from which probable future actions by the users may be extrapolated (col 30, line 50 - col 31, line 15 and col 39, lines 5-29). Lawlor discloses the past transaction information including information such as the user's spending patterns. Spending pattern information is used extensively by the retail arts to project future spending by the individual. Thus, the inclusion of this type of information in Lawlor reads on the above limitation. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such data in the Rudow system when selecting the advertisements. One would have been motivated to extrapolate probable future actions by the user in order to better target the advertisement.

Claims 4, 17, 28, 49, and 62: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, 23, 43, 46 and 59 above; and Lawlor further discloses that the past transaction information includes information about past commercial activities of the user (col 15, lines 36-49 and col 30, line 55 - col 31, line 15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such data in the Rudow system when selecting the advertisements. One would have been motivated to include the past commercial activities in order to better target the advertisement.

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Claims 7, 8, 50, 51, 63, and 64: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 1, 46, and 59 above; and Lawlor further discloses a plurality of information providers who provide the information based on the past transactions of the user (col 17, lines 62-67 and col 18, lines 12-17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to receive information from such entities in the Rudow system when selecting the advertisements. One would have been motivated to include information from a plurality of information providers in order to better target the advertisement.

Claims 9, 52, and 65: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 8, 51, and 64 above, and Rudow further discloses that the advertisement (information) could be from the clubhouse or other advertiser. Lawlor also discloses that the advertisement (information) could be for a loan (i.e. from a bank or financial institution) or “used to advertise any good or service.” (col 39, lines 13-22). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the information provider could be any entity wishing to present information to the user. One would have been motivated to include information from such sources as car rental agencies, hotels, restaurants, etc. in order to expand the utility of the system.

Claims 11, 12, 54, 55, 67, and 68: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 1, 46, and 59 above, and Rudow further discloses using the Global Positioning Satellite (GPS) system and local

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transceivers to determine the exact location of the golf cart (or hand held device) on the golf course and to transmit information (such as distance to hole, recommended golf club to use, etc.) to the golfer based on the location of the golf cart (col 6, lines 53-55). The system also can be used to transmit other information to the golfer, such as advertisements and personal messages.

Claims 21, 22, 34, 35, 36, 38, 56, and 69: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 13, 23, 46 and 59 above; and Lawlor further discloses that the information comprises promotions/advertisements based on the past transactions of the user (col 13, lines 42-59; col 15, lines 36-49; and col 30, line 50 - col 31, line 15). While neither reference explicitly discloses that the past transaction was a car rental transaction by the user, Lawlor's disclosure of using past transaction data would encompass any and all types of transactions to include car rentals. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such data in the Rudow system when selecting the advertisements. One would have been motivated to include base the selection of the advertisement on such historical data in order to better target the advertisement.

Claim 31: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claim 23 above, and Lawlor further discloses the user of the mobile device transmitting an inquiry and the information provider transmitting information in response to the inquiry (col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 33, lines 58-66). Therefore, it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to allow the user in the Rudow system to submit inquiries and receive responses. One would have been motivated to allow user inquiries in order to better target the information to the needs of the user.

Claim 32: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claim 23 above, and Lawlor further discloses the information provider determines if a service is required and provides the service to the user upon detection of the user within the monitored area (col 15, lines 36-49; col 30, line 55 - col 31, line 15; col 33, lines 58-66; and col 50, lines 50-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a service in the Rudow system. One would have been motivated to include such a service in order to better meet the needs of the user.

Claims 53 and 66: Rudow and Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 51, and 64 above, and Rudow also discloses maintaining information pertaining to the topography of the network (i.e. location of access points/repeaters). The other claimed information being stored in the database, such as a directory of the elements coupled to the network (i.e. a list of the repeaters and remote device identification numbers), the characteristics of such elements, and performance and trend statistics of the network are all well known information that is usually tracked and stored as part of the network and database management systems and would have been obvious to add to the Rudow system. Furthermore, since this information is not used in these or any other claims, but merely

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identified as being in a database, the type of information stored therein is merely non-functional data per se for which non patentable weight is given.

Response to Arguments

5. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

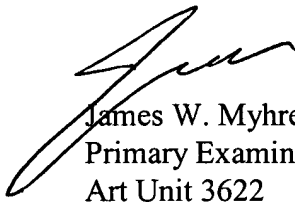
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
July 8, 2003


James W. Myhre
Primary Examiner
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